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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,879	01/17/2001	Naohito Takae	1341.1077 (JDH)	4985

21171 7590 03/27/2006	EXAMINER	
STAAS & HALSEY LLP	RAMOS FELICIANO, ELISEO	
SUITE 700	ART UNIT	PAPER NUMBER
1201 NEW YORK AVENUE, N.W.	2617	
WASHINGTON, DC 20005		

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 January 2006</u>.

2a)☐ This action is **FINAL.** 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5,7-9 and 11-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5,7-9 and 11-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on January 5, 2006 has been entered.

Claim Objections

2.   **Claim 20** is objected to because of the following informalities: the language of the claim

is non standard and awkward. The claim is not written to recite positive and active steps. For

example, --modifying-- instead of "causing to be modified". See 37 CFR 1.75 and MPEP

608.01(i)-(p). Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

4.   **Claim 20** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

      Claim 20 recites the limitation "substantially simultaneously" in line 4. It is not clear

whether simultaneous or not. For examination of the merits is not assumed to be simultaneous.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   **Claims 1, 3-5, 7-9, and 11-20** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Hubbe et al. (US Patent Number 6,278,885) in view of Rignell et al. (US Patent Application

publication number 2001/0053688 A1).

Regarding **claim 1**, Hubbe et al. discloses a portable terminal remote control method of

remotely controlling a portable terminal (3) from an external device (1, 2, 5) via a wireless

communication link (Figure 1), said portable terminal having a main body provided with a built-

in memory (second memory – column 5, line 1), and an attachable/detachable storage medium

(first memory, e.g. SIM card – column 4, line 65), the method comprising:

accepting a request by said external device related to a change of setting in said portable

terminal via the wireless communication link (column 3, lines 27-32); and

sending a single setting changing message (short radio message; SMS – abstract; column

3, lines 35-40; column 5, lines 4-9), from said external device to said portable terminal, in

response to the accepted request (column 3, lines 27-32), and

wherein the setting changing message includes a computer program ("commands to be

acted on" – column 4, line 3; "updating commands" – column 3, lines 27-32) that changes

contents of the built-in memory together with contents of the storage medium of the portable

terminal at a time (column 5, lines 2-3), and a setting changing identifier (header 6 – Figure 2)

that identifies the setting changing message such that said portable terminal is configured to

execute a different function (an update by definition implies a change or different function as claimed; see "adding software" – column 4, line 47) (column 2, lines 26-34).

• In spite of that someone makes the request (which includes a settings change for the portable terminal; Hubbe et al.'s "updating commands"), Hubbe et al. does not specify it is the user of the portable terminal who makes the request. Nevertheless, the manner of operating a device does not differentiate apparatus claim from the prior art (see MPEP 2114).

On the other hand, this feature is conventional in the art as shown by Rignell et al. In the same field of endeavor, Rignell et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (201 – Figure 2) wherein the user of the portable terminal makes the request as claimed (see in particular paragraph 0029).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable the user of the portable terminal to make the request instead of or in addition to someone else, first, because the manner of operating a device does not differentiate apparatus claim from the prior art (MPEP 2114), and, second, because users would be capable of performing the changes/updates when necessary, possible, and/or advantageous (e.g. when they have time).

• Even though Hubbe et al. discloses that the setting changing message is, for example, SMS (short message service) message (abstract; column 3, lines 35-40; column 5, lines 4-9), Hubbe et al. fails to specify that the setting changing message is mail (e-mail) as defined by applicant.

In the same field of endeavor, Rignell et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (201 – Figure 2) where either one of SMS or

e-mail or any other suitable format can be used to send update/support information/commands

enabling the mobile unit to perform an update of the settings in a memory of the mobile unit (see

in particular paragraph 0107; see also paragraphs 0037 and 0084). SMS and e-mail are

interchangeable as suggested by Rignell et al. Some advantages of e-mail are that it is low cost,

and widely available.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to use e-mail instead of SMS, first, because SMS and e-mail are

interchangeable as suggested by Rignell et al., and, second, because e-mail is low cost, and

widely available.

Regarding **claim 3**, Hubbe et al. and Rignell et al. disclose everything claimed as applied

above (see *claim 1*). In addition, the combination teaches wherein the sending of the setting

changing mail includes, upon acceptance of the request related to the change of setting in said

portable terminal, generating the setting changing mail containing a computer program suitable

to the received request (column 2, lines 26-34; column 3, lines 27-40; column 4, line 3; column

5, lines 4-9 of Hubbe et al.).

Regarding **claim 4**, Hubbe et al. and Rignell et al. disclose everything claimed as applied

above (see *claim 3*). In addition, the combination teaches the upon acceptance of the request

related to the change of setting in said portable terminal from the user of said portable terminal,

checking whether or not the user is an authorized user (determine whether unauthorized,

unsupported, unlicensed or unofficial – paragraphs 0051-0052 of Rignell et al.).

Regarding **claim 5**, Hubbe et al. discloses a portable terminal remote control method of

remotely controlling a portable terminal (3) from an external deice (1, 2, 5) via a wireless

communication link (Figure 1), said portable terminal having a main body provided with a built-in memory (second memory – column 5, line 1), and an attachable/detachable storage medium (first memory, e.g. SIM card – column 4, line 65), the method comprising:

receiving a single setting changing message (short radio message; SMS – abstract; column 3, lines 35-40; column 5, lines 4-9) sent from said external device in said portable terminal, via the wireless communication link (column 3, lines 27-32), the setting changing message including a computer program ("commands to be acted on" – column 4, line 3; "updating commands" – column 3, lines 27-32) that changes contents of both the built-in memory and the storage medium of the portable terminal at a time (column 5, lines 2-3), and a setting changing identifier (header 6 – Figure 2) that identifies the setting changing mail;

identifying the setting changing message based on the setting changing identifier (header 6 – Figure 2); and

updating the contents of both of said built-in memory and said storage medium collectively (e.g. "both") based on content of the received setting changing mail such that said portable terminal is configured to execute a different function (an update by definition implies a change or different function as claimed; see "adding software" – column 4, line 47), and where the updating is executed upon a corresponding receipt of the single setting changing message via said built-in memory and said storage medium (column 4, lines 47-61; column 2, lines 26-34).

• Even though Hubbe et al. discloses that the setting changing message is, for example, SMS (short message service) message (abstract; column 3, lines 35-40; column 5, lines 4-9), Hubbe et al. fails to specify that the setting changing message is mail (e-mail) as defined by applicant.

In the same field of endeavor, Rignell et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (201 – Figure 2) where either one of SMS or e-mail or any other suitable format can be used to send update/support information/commands enabling the mobile unit to perform an update of the settings in a memory of the mobile unit (see in particular paragraph 0107; see also paragraphs 0037 and 0084). SMS and e-mail are interchangeable as suggested by Rignell et al. Some advantages of e-mail are that it is low cost, and widely available. Rignell et al. further discloses a setting changing identifier (software version number) that identifies the setting changing mail; and identifying the setting changing message based on the setting changing identifier (paragraph 0044, 0077, 0091, etc).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use e-mail instead of SMS, first, because SMS and e-mail are interchangeable as suggested by Rignell et al., and, second, because e-mail is low cost, and widely available.

Regarding **claim 7**, Hubbe et al. and Rignell et al. disclose everything claimed as applied above (see *claim 5*). In addition, the combination teaches wherein said storage medium comprises an IC card or a subscriber identity module card (e.g. SIM card – column 3, lines 4-5; column 4, line 65) issued by a communication provider (column 3, lines 23-25), each provided with a processor (processing means; microprocessor – column 3, lines 7-10) (17 – Figure 3) and a memory (column 3, lines 7-10) (18 – Figure 3) so that in the collectively updating of the contents, said main body has a processor (11 – Figure 3) that updates the contents of said built-in memory (12 – Figure 3) by executing the computer program contained in said setting changing mail ("commands to be acted on" – column 4, line 3; "updating commands" – column 3, lines

27-32), and said IC card or subscriber identity module card is updated by a processor-to-

processor communication between the processor in said main body and the processor in said IC

card or in said subscriber identity module card (e.g. SIM card) (column 3, lines 11-15; and

citations above of Hubbe et al.).

Regarding **claim 8**, Hubbe et al. and Rignell et al. disclose everything claimed as applied

above (see *claim 5*). In addition, the combination teaches storing the received setting changing

mail in said built-in memory (column 5, lines 2-3); and when said storage medium is replaced

with another storage medium, updating contents of said other storage medium by running the

computer program contained in the setting changing mail stored in said built-in memory (single

phone can use multiple cards or *vice versa* – column 4, lines 8-14; card memory contents are

compared against built-in memory, e.g. buffer, to determine update need – column 4, lines 51-

55; and citations above of Hubbe et al.).

Regarding **claim 9**, Hubbe et al. and Rignell et al. disclose everything claimed as applied

above (see *claim 5*). In addition, the combination teaches storing the received setting changing

mail said storage medium (column 5, lines 2-3); and when said storage medium is inserted into a

main body of another portable terminal, updating contents in a built-in memory of said mail body

of the other portable terminal by running the computer program contained in the setting changing

mail stored in said storage medium (single card can be used in multiple phones or *vice versa* –

column 4, lines 8-14; card memory contents are compared against built-in memory, e.g. buffer,

to determine update need – column 4, lines 51-55; and citations above of Hubbe et al.).

In general, **claims 11-20** are obvious variations of **claims 1, 3-5, 7-9**; therefore, they

rejected for the same reasons shown above. For example:

As to **claims 11 and 12**, they are the corresponding system and recording medium claims of method *claim 1*; therefore, they are rejected for the same reasons applied above for *claim 1*.

As to **claim 13**, it is a corresponding system claim of method *claim 5*; therefore, it is rejected for the same reasons applied above for *claim 5*.

As to **claims 14 and 18-20**, they are obvious variation method claims corresponding to method *claim 1*; therefore, they are rejected for the same reasons applied above for *claim 1*.

As to **claims 15 and 16**, they are the corresponding system and recording medium claims of method *claim 14*; therefore, they are rejected for the same reasons applied above for *claim 14*.

As to **claim 17**, it is a corresponding system claim of method *claim 4/3/1*; therefore, it is rejected for the same reasons applied above for *claim 4/3/1*.

7.   **Claims 1, 3-5, 7-9, and 11-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbe et al. (US Patent Number 6,278,885) in view of Hägebarth (US Patent Number 6,484,026).

Regarding **claim 1**, Hubbe et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (3) from an external device (1, 2, 5) via a wireless communication link (Figure 1), said portable terminal having a main body provided with a built-in memory (second memory – column 5, line 1), and an attachable/detachable storage medium (first memory, e.g. SIM card – column 4, line 65), the method comprising:

accepting a request by said external device related to a change of setting in said portable terminal via the wireless communication link (column 3, lines 27-32); and

sending a single setting changing message (short radio message; SMS – abstract; column

3, lines 35-40; column 5, lines 4-9), from said external device to said portable terminal, in

response to the accepted request (column 3, lines 27-32), and

wherein the setting changing message includes a computer program ("commands to be

acted on" – column 4, line 3; "updating commands" – column 3, lines 27-32) that changes

contents of the built-in memory together with contents of the storage medium of the portable

terminal at a time (column 5, lines 2-3), and a setting changing identifier (header 6 – Figure 2)

that identifies the setting changing message such that said portable terminal is configured to

execute a different function (an update by definition implies a change or different function as

claimed; see "adding software" – column 4, line 47) (column 2, lines 26-34).

• In spite of that someone makes the request (which includes a settings change for the

portable terminal; Hubbe et al.'s "updating commands"), Hubbe et al. does not specify it is the

user of the portable terminal who makes the request. Nevertheless, the manner of operating a

device does not differentiate apparatus claim from the prior art (see MPEP 2114).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to enable the user of the portable terminal to make the request instead of

or in addition to someone else, first, because the manner of operating a device does not

differentiate apparatus claim from the prior art (MPEP 2114), and, second, because users would

be capable of performing the changes/updates when necessary, possible, and/or advantageous

(e.g. when they have time).

• Even though Hubbe et al. discloses that the setting changing message is, for example,

SMS (short message service) message (abstract; column 3, lines 35-40; column 5, lines 4-9),

Hubbe et al. fails to specify that the setting changing message is mail (e-mail) as defined by applicant.

In the same field of endeavor, Hägebarth discloses a portable terminal remote control method of remotely controlling a portable terminal (abstract) where either one of SMS or e-mail can be used to send update/performance parameters/commands (settings) enabling the mobile unit to perform an update of the settings in a memory of the mobile unit (see in particular column 6, lines 34-41; see also column 7, lines 35-38). SMS and e-mail are interchangeable as suggested by Hägebarth. Some advantages of e-mail are that it is low cost, and widely available.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use e-mail instead of SMS, first, because SMS and e-mail are interchangeable as suggested by Hägebarth, and, second, because e-mail is low cost, and widely available.

Regarding **claim 3**, Hubbe et al. and Hägebarth disclose everything claimed as applied above (see *claim 1*). In addition, the combination teaches wherein the sending of the setting changing mail includes, upon acceptance of the request related to the change of setting in said portable terminal, generating the setting changing mail containing a computer program suitable to the received request (column 2, lines 26-34; column 3, lines 27-40; column 4, line 3; column 5, lines 4-9 of Hubbe et al.).

Regarding **claim 4**, Hubbe et al. and Hägebarth disclose everything claimed as applied above (see *claim 3*). In addition, the combination teaches the upon acceptance of the request related to the change of setting in said portable terminal from the user of said portable terminal,

checking whether or not the user is an authorized user (verify customer's identity – column 5, lines 1-6 of Hägebarth).

Regarding **claim 5**, Hubbe et al. discloses a portable terminal remote control method of remotely controlling a portable terminal (3) from an external deice (1, 2, 5) via a wireless communication link (Figure 1), said portable terminal having a main body provided with a built-in memory (second memory – column 5, line 1), and an attachable/detachable storage medium (first memory, e.g. SIM card – column 4, line 65), the method comprising:

receiving a single setting changing message (short radio message; SMS – abstract; column 3, lines 35-40; column 5, lines 4-9) sent from said external device in said portable terminal, via the wireless communication link (column 3, lines 27-32), the setting changing message including a computer program ("commands to be acted on" – column 4, line 3; "updating commands" – column 3, lines 27-32) that changes contents of both the built-in memory and the storage medium of the portable terminal at a time (column 5, lines 2-3), and a setting changing identifier (header 6 – Figure 2) that identifies the setting changing mail;

identifying the setting changing message based on the setting changing identifier (header 6 – Figure 2); and

updating the contents of both of said built-in memory and said storage medium collectively (e.g. "both") based on content of the received setting changing mail such that said portable terminal is configured to execute a different function (an update by definition implies a change or different function as claimed; see "adding software" – column 4, line 47), and where the updating is executed upon a corresponding receipt of the single setting changing message via said built-in memory and said storage medium (column 4, lines 47-61; column 2, lines 26-34).

• Even though Hubbe et al. discloses that the setting changing message is, for example,

SMS (short message service) message (abstract; column 3, lines 35-40; column 5, lines 4-9),

Hubbe et al. fails to specify that the setting changing message is mail (e-mail) as defined by

applicant.

In the same field of endeavor, Hägebarth discloses a portable terminal remote control

method of remotely controlling a portable terminal (abstract) where either one of SMS or e-mail

can be used to send update/performance parameters/commands (settings) enabling the mobile

unit to perform an update of the settings in a memory of the mobile unit (see in particular column

6, lines 34-41; see also column 7, lines 35-38). SMS and e-mail are interchangeable as suggested

by Hägebarth. Some advantages of e-mail are that it is low cost, and widely available.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to use e-mail instead of SMS, first, because SMS and e-mail are

interchangeable as suggested by Hägebarth, and, second, because e-mail is low cost, and widely

available.

Regarding **claim 7**, Hubbe et al. and Hägebarth disclose everything claimed as applied

above (see *claim 5*). In addition, the combination teaches wherein said storage medium

comprises an IC card or a subscriber identity module card (e.g. SIM card – column 3, lines 4-5;

column 4, line 65) issued by a communication provider (column 3, lines 23-25), each provided

with a processor (processing means; microprocessor – column 3, lines 7-10) (17 – Figure 3) and

a memory (column 3, lines 7-10) (18 – Figure 3) so that in the collectively updating of the

contents, said main body has a processor (11 – Figure 3) that updates the contents of said built-in

memory (12 – Figure 3) by executing the computer program contained in said setting changing

mail ("commands to be acted on" – column 4, line 3; "updating commands" – column 3, lines 27-32), and said IC card or subscriber identity module card is updated by a processor-to-processor communication between the processor in said main body and the processor in said IC card or in said subscriber identity module card (e.g. SIM card) (column 3, lines 11-15; and citations above of Hubbe et al.).

Regarding **claim 8**, Hubbe et al. and Hägebarth disclose everything claimed as applied above (see *claim 5*). In addition, the combination teaches storing the received setting changing mail in said built-in memory (column 5, lines 2-3); and when said storage medium is replaced with another storage medium, updating contents of said other storage medium by running the computer program contained in the setting changing mail stored in said built-in memory (single phone can use multiple cards or *vice versa* – column 4, lines 8-14; card memory contents are compared against built-in memory, e.g. buffer, to determine update need – column 4, lines 51-55; and citations above of Hubbe et al.).

Regarding **claim 9**, Hubbe et al. and Hägebarth disclose everything claimed as applied above (see *claim 5*). In addition, the combination teaches storing the received setting changing mail said storage medium (column 5, lines 2-3); and when said storage medium is inserted into a main body of another portable terminal, updating contents in a built-in memory of said mail body of the other portable terminal by running the computer program contained in the setting changing mail stored in said storage medium (single card can be used in multiple phones or *vice versa* – column 4, lines 8-14; card memory contents are compared against built-in memory, e.g. buffer, to determine update need – column 4, lines 51-55; and citations above of Hubbe et al.).

In general, **claims 11-20** are obvious variations of **claims 1, 3-5, 7-9**; therefore, they

rejected for the same reasons shown above. For example:

As to **claims 11 and 12**, they are the corresponding system and recording medium claims

of method *claim 1*; therefore, they are rejected for the same reasons applied above for *claim 1*.

As to **claim 13**, it is a corresponding system claim of method *claim 5*; therefore, it is

rejected for the same reasons applied above for *claim 5*.

As to **claims 14 and 18-20**, they are obvious variation method claims corresponding to

method *claim 1*; therefore, they are rejected for the same reasons applied above for *claim 1*.

As to **claims 15 and 16**, they are the corresponding system and recording medium claims

of method *claim 14*; therefore, they are rejected for the same reasons applied above for *claim 14*.

As to **claim 17**, it is a corresponding system claim of method *claim 4/3/1*; therefore, it is

rejected for the same reasons applied above for *claim 4/3/1*.

Response to Arguments

8.   Applicant's arguments filed January 5, 2006 have been fully considered but they are not

persuasive.

9.   Applicant argues claims rejected over Hubbe et al., Rignell et al. AND Hägebarth (see

page 8 of arguments).

Examiner disagrees because claims have been separately rejected over (1) Hubbe et al.

and Rignell et al.; or (2) Hubbe et al. and Hägebarth.

10.   In response to applicant's argument that Hubbe is limited to certain advantages (see page

8, second paragraph under "Rejection" subheading of arguments), the fact that applicant has

recognized another advantage which would flow naturally from following the suggestion of the

prior art cannot be the basis for patentability when the differences would otherwise be obvious.

See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

11.   In response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

12.   Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a

general allegation that the claims define a patentable invention without specifically pointing out

how the language of the claims patentably distinguishes them from the references.

Conclusion

13.   Any inquiry concerning this communication from the examiner should be directed to
Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally
be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Marsha Banks-Harold, can be reached on (571) 272-7905. The fax phone number for
the organization where this application or proceeding is assigned is 571-273-8300.
        Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
applications is available through Private PAIR only. For more information about the PAIR
system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR
system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELISEO RAMOS-FELICIANO
    PRIMARY EXAMINER

ERF/erf
March 17, 2006